



PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**TRANSMITTAL  
FORM**

(to be used for all correspondence after initial filing)

<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	10/761,351
	Filing Date	January 22, 2004
	First Named Inventor	Craig ULLMAN
	Art Unit	2154
	Examiner Name	Viet Duy Vu
Total Number of Pages in This Submission	Attorney Docket Number	559442600207

**ENCLOSURES (Check all that apply)**

<input checked="" type="checkbox"/> Fee Transmittal Form  <input type="checkbox"/> Fee Attached  <input type="checkbox"/> Amendment/Reply  <input type="checkbox"/> After Final  <input type="checkbox"/> Affidavits/declaration(s)  <input type="checkbox"/> Extension of Time Request  <input type="checkbox"/> Express Abandonment Request  <input checked="" type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Document(s)  <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application  <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s)  <input type="checkbox"/> Licensing-related Papers  <input type="checkbox"/> Petition  <input type="checkbox"/> Petition to Convert to a Provisional Application  <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address  <input type="checkbox"/> Terminal Disclaimer  <input type="checkbox"/> Request for Refund  <input type="checkbox"/> CD, Number of CD(s) _____  <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC  <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences  <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)  <input type="checkbox"/> Proprietary Information  <input type="checkbox"/> Status Letter  <input checked="" type="checkbox"/> Other Enclosure(s) (please Identify below):  Return Receipt Postcard
<b>Remarks</b>		

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm Name	MORRISON & FOERSTER LLP		
Signature			
Printed name	James M. Denaro		
Date	May 17, 2006	Reg. No.	54,063



PTO/SB/17 (01-06)  
Approved for use through 7/31/2006. OMB 0651-0032  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE  
For the purposes of the Paperwork Reduction Act of 1995, no person are required to respond to a collection of information unless it displays a valid OMB control number.

<b>FEE TRANSMITTAL</b> <b>For FY 2006</b>		<b>Complete if Known</b>	
		Application Number	10/761,351
		Filing Date	January 22, 2004
		First Named Inventor	Craig ULLMAN
		Examiner Name	Viet Duy Vu
		Art Unit	2154
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27		Attorney Docket No.	559442600207
<b>TOTAL AMOUNT OF PAYMENT</b>	<b>(\$)</b> 180.00		

<b>METHOD OF PAYMENT</b> (check all that apply)	
<input type="checkbox"/> Check	<input type="checkbox"/> Credit Card
<input type="checkbox"/> Money Order	<input type="checkbox"/> None
<input type="checkbox"/> Other (please identify): _____	
<input checked="" type="checkbox"/> Deposit Account	Deposit Account Number: 03-1952
Deposit Account Name: Morrison & Foerster LLP	
For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)	
<input checked="" type="checkbox"/> Charge fee(s) indicated below	<input type="checkbox"/> Charge fee(s) indicated below, except for the filing fee
<input checked="" type="checkbox"/> Charge any additional fee(s) or underpayment of fee(s) under 37 CFR 1.16 and 1.17	<input checked="" type="checkbox"/> Credit any overpayments

<b>FEE CALCULATION (All the fees below are due upon filing or may be subject to a surcharge.)</b>							
<b>1. BASIC FILING, SEARCH, AND EXAMINATION FEES</b>							
	<b>FILING FEES</b>		<b>SEARCH FEES</b>		<b>EXAMINATION FEES</b>		
		<b>Small Entity</b>		<b>Small Entity</b>		<b>Small Entity</b>	
<b>Application Type</b>	<b>Fee (\$)</b>	<b>Fee (\$)</b>	<b>Fee (\$)</b>	<b>Fee (\$)</b>	<b>Fee (\$)</b>	<b>Fee (\$)</b>	<b>Fees Paid (\$)</b>
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	
<b>2. EXCESS CLAIM FEES</b>							
<b>Fee Description</b>						<b>Small Entity</b>	
						<b>Fee (\$)</b>	<b>Fee (\$)</b>
Each claim over 20 (including Reissues)						50	25
Each independent claim over 3 (including Reissues)						200	100
Multiple dependent claims						360	180
<b>Total Claims</b>	<b>Extra Claims</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>	<b>Multiple Dependent Claims</b>			
	- 20 =	x	=	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>		
HP = highest number of total claims paid for, if greater than 20.							
<b>Indep. Claims</b>	<b>Extra Claims</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>				
	- 3 =	x	=				
HP = highest number of independent claims paid for, if greater than 3.							
<b>3. APPLICATION SIZE FEE</b>							
If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).							
<b>Total Sheets</b>	<b>Extra Sheets</b>	<b>Number of each additional 50 or fraction thereof</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>			
	- 100 =	/50	(round up to a whole number) x	=			
<b>4. OTHER FEE(S)</b>							
							<b>Fees Paid (\$)</b>
Non-English Specification, \$130 fee (no small entity discount)							
Other (e.g., late filing surcharge): 1806 Submission of an Information Disclosure Statement							180.00

<b>SUBMITTED BY</b>			
Signature		Registration No. (Attorney/Agent)	54,063
Name (Print/Type)	James M. Denaro	Telephone	(703) 760-7739
		Date	May 17, 2006



Atty. Docket No. 559442600207

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:  
Craig ULLMAN et al.

Serial No.: 10/761,351

Filing Date: January 22, 2004

For: ENHANCED VIDEO PROGRAMMING  
SYSTEM AND METHOD FOR  
INCORPORATING AND DISPLAYING  
RETRIEVED INTEGRATED INTERNET  
INFORMATION SEGMENTS

Examiner: Viet Duy Vu

Group Art Unit: 2154

**SUPPLEMENTAL INFORMATION  
DISCLOSURE STATEMENT**

MS Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

Pursuant to 37 C.F.R. §1.97 and § 1.98 and MPEP 2001.06(c), applicant submits for consideration in the above-identified application the following disclosure. All of the documents identified below are believed to be of record already. If an additional copy of any document is required, the Examiner is invited to contact applicant.

These documents were cited by defendants in the matter of ACTV, Inc. and HyperTV Networks Inc. v. The Walt Disney Co., ABC, Inc. and ESPN, Inc in U.S. District Court for the Southern District of New York (Civil Action No. 00 Civ. 9622 JSR) as relevant to the validity of one or more claims in U.S. Patent Nos. 5,778,181 (Ser. No. 615,143), 5,774,664 (Ser. No. 622,474) and 6,018,768 (U.S. Ser. No. 09/109,945). Applicant would appreciate the Examiner initialing and returning the Form PTO/SB/08a/b, indicating that the information has been considered and made of record herein.

05/18/2006 10:00:01 00000051 031952 10761351  
01 FC:1806 188.00 DA

In the above-referenced legal proceeding, defendants also alleged inequitable conduct in the prosecution of the '181, '664 and '768 patents. The '768 patent is a continuation-in-part of the '181 patent and is related to the '664 patent.

- a) Defendants alleged intentional failure to disclose U.S. Patent No. 5,479,268 to Young et al. in prosecution of the above-referenced patents. Patent-owner showed that the '268 patent is cumulative with U.S. Patent No. 5,589,892 to Knee et al. which was cited by the Examiner during prosecution of the '181 patent. Patent-owner also showed that the same examiner responsible for examining the '181, '664 and '768 patents issued a search report in a PCT application claiming priority to the '181 and '664 patents in which the '268 was cited as being of "particular relevance."
- b) Defendants alleged misrepresentation in the "Summary of the Invention" sections of the above-referenced patents of the prior art Intericast system as a one-way analog instead of a two-way digital system. Patent-owner showed that the Intericast product literature distinguishes the Intericast system from two-way systems and that each of the three co-inventors of the Intericast system testified in depositions that the Intericast system is a one-way analog system.
- c) Defendants alleged intentional failure to disclose that the subject matter of claims 19 and 20 of the '768 patent was on sale as of July 6, 1997, more than one year prior to its filing. Patent-owner showed that the Examiner found that claim 19 was fully supported by earlier disclosures including application Serial No. 613,144, filed on March 8, 1996, and in the application that matured into the '181 patent. Patent-owner showed that the subject matter of claim 20 was not complete and ready for patenting before July 7, 1997 and that the claims of the '768 patent were supported by the '181 patent.

- d) Defendants alleged intentional failure to disclose U.S. Patent No. 5,761,606 to Wolzien in prosecution of the '768 patent. Patent-owner showed that the '606 patent was cited by the Examiner during prosecution of the application that issued as the '768 patent.
- e) Defendants alleged intentional failure to disclose U.S. Patent No. 5,818,441 to Throckmorton et al. in prosecution of the '768 patent. Patent-owner showed that there was no evidence that the inventors or the prosecuting attorney had reviewed the '441 patent until after the '768 patent had already issued. Patent-owner also showed that the '441 patent was cumulative with the Intericast system and the '606 patent to Wolzien.
- f) Defendants alleged intentional misrepresentation in prosecution of the '768 patent by the assertion that ACTV had a one hundred percent ownership interest in the '181 and '664 patents. Patent-owner showed that the assignments made in the '181 and '664 patents reflect that the inventors of the '181 and '664 patents had sold, assigned and transferred their entire right, title and interest in those patents to ACTV.

The above-referenced case was settled and no decision on the merits was reached with respect to these contentions. The relevant pleadings were filed under seal pursuant to a protective order and are not publicly available. Applicant asserts that the above description of the allegations made and responses plead is accurate and complete.

The information contained in this Supplemental Information Disclosure Statement under 37 C.F.R. § 1.97 and § 1.98 is not to be construed as a representation that: (i) a complete search has been made; (ii) additional information material to the examination of this application does not exist; (iii) the information, protocols, results and the like reported by third parties are accurate or enabling; (iv) the above information constitutes prior art to the subject invention; (v) applicant admits to the inequitable conduct allegations in whole or in part.

In the unlikely event that the transmittal form is separated from this document and the Patent Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. §

Application No: 10/761,351

Atty. Docket No. 559442600207

1.17 (p)) is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing 559442600207.

Dated: May 17, 2006

Respectfully submitted,

By 

James M. Denaro

Registration No.: 54,063

MORRISON & FOERSTER LLP

1650 Tysons Blvd, Suite 300

McLean, Virginia 22102

(703) 760-7700



ALTERNATIVE TO PTO/SB/08a/b (07-05)

<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>  (Use as many sheets as necessary)				<b>Complete if Known</b>	
				Application Number	10/761,351
				Filing Date	January 22, 2004
				First Named Inventor	Craig ULLMAN
				Art Unit	2154
				Examiner Name	Viet Duy Vu
Sheet	1	of	1	Attorney Docket Number	559442600207

U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. <sup>1</sup>	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code <sup>2</sup> (if known)			
	1.	5,479,268	12/26/1995	Young et al.	
	2.	5,724,103	3/3/1998	Batchelor	
	3.	5,761,606	6/2/1998	Wolzien	
	4.	5,782,692	6/21/1998	Stelovsky	
	5.	5,818,441	10/6/1998	Throckmorton et al.	
	6.	5,905,865	5/18/1999	Palmer et al.	

FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T <sup>6</sup>
		Country Code <sup>3</sup> -Number <sup>4</sup> -Kind Code <sup>5</sup> (if known)				
						✓

\*EXAMINER: Initial if information considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. <sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.

NON PATENT LITERATURE DOCUMENTS				
Examiner Initials	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.		T <sup>2</sup>
	7.	Press Release, InterCast Industry Group, <i>Leaders in PC, Broadcast and Cable Industries Announce Formation of Industry Group to Promote New Digital Medium for the Home PC</i> , Business Wire, Oct. 23, 1995.		
	8.	Per Einar Dybvik and Hakon W. Lie, <i>Combining WWW/Mosaic with Realtime Multimedia Conferencing in Distance Education</i> , the Second International WWW Conference '94, Mosaic and the Web, Advance Proceedings, Vol. 1, October 17-20, 1994, at 423.		
	9.	Tak K. Woo and Michael J. Rees, <i>A Synchronous Collaboration Tool for the World-Wide Web</i> , The Second International WWW Conference '94, Mosaic and the Web, Advance Proceedings, Vol. 1, October 17-20, 1994, at 315.		
	10.	Vinay Kumar, Jay Glicksman and Glenn A. Kramer, <i>A SHAReD Web to Support Design Teams</i> , Third Workshop on Enabling Technologies: Infrastructure for Collaborative Enterprises, Morgantown, West Virginia, April 17-19, at 178.		

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> Applicant is to place a check mark here if English language Translation is attached.

Examiner Signature		Date Considered	
-----------------------	--	--------------------	--

va-163136